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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,662	06/14/2005	Atsushi Ogawa	83363.0012	6654
26021 7590 11/28/2007 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER YABUT, DIANE D	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/539,662

Applicant(s)

OGAWA ET AL.

Examiner

Diane Yabut

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This action is in response to applicant's amendment received on 13 September 2007.

The examiner acknowledges the amendments made to the claims.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ken** (U.S. Patent No. **6,013,084**) in view of **Bashiri** (U.S. Patent No. **6,468,266**) and **Teoh** (U.S. Pub. No. **20040002732**).

Claims 1 and 8: Ken discloses an indwelling implant for embolization comprising a coil **191** that may be composed of a metal and a substantially semi-spherical rounded head portion at the distal end portion of the coil, wherein a loop **199** is provided inside said coil from said head portion of the coil toward the proximal end portion of the coil, and an axial extension controlling member **193** composed of at least one wire material and it is provided inside said coil by extending the member in the coil axial direction of said coil and fixing both ends thereof directly or indirectly to the proximal end portion in the inside of the coil after the member passed through said loop, wherein the loop is directly coupled to the axial extension controlling member (Figure 10, col. 5, lines 10-23 and col. 9, lines 29-51). Ken discloses the claimed device except for the axial extension

controlling member being composed of at least one wire material which is thinner than the metal wire material forming said loop, the loop being a single closed loop that is directly fixed to the rounded head portion.

Bashiri teaches a coil **120** with an axial extension controlling member **134** composed of at least one wire material which is thinner than the metal wire material forming said loop **138** (Figure 3). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a thinner material for the axial extension controlling member than the material forming said loop, as taught by Bashiri, to Ken in order to ensure a secure engagement with the loop and to prevent the coil from stretching when the coil is being repositioned (col. 5, line 58 to col. 6, line 18).

Teoh teaches a vaso-occlusive coil with a single closed loop **108** that is directly fixed to a rounded head portion **107**. It would have been obvious to one of ordinary skill in the art at the time of invention to provide a single closed loop directly fixed to a rounded portion, as taught by Teoh, to Ken since a closed loop configuration is identified as a coupling mechanism to other portions of the vaso-occlusive device (page 5, paragraph 52), which is well known in the art for secure linking or attachment of segments along a device.

Claims 2-3: Ken discloses the axial extension controlling member and loop being composed of the same metal material as the coil, such as platinum or a platinum alloy (col. 5, lines 10-23).

Claim 4: Ken discloses the axial extension controlling member being composed of a wire material with a diameter of 20 $\mu$ m or less (col. 5, lines 57-67, col. 6, lines 1-14 and col. 7, lines 1-7).

Claim 6: Ken, Bashiri, and Wilson disclose the claimed device except for the axial extension controlling member being further twisted after insertion through the loop.

Teoh teaches an axial extension controlling member being further twisted after insertion through the loop in order to keep the wire from collapsing on itself (Figures 2C-2D and page 6, paragraphs 55-56). It would have been obvious to one of ordinary skill in the art at the time of invention to provide the axial extension controlling member being further twisted, as taught by Teoh, to Ken, Bashiri, and Wilson in order to keep the wire from collapsing on itself, and therefore to maintain its function.

Claim 7: Ken discloses the coil being further formed to have a secondary shape (col. 9, lines 29-51).

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ken** (U.S. Patent No. **6,013,084**), **Bashiri** (U.S. Patent No. **6,468,266**), and **Teoh** (U.S. Pub. No. **20040002732**), as applied to Claim 4 above, and further in view of **Wilson** (U.S. Pub. No. **20040034363**).

Claim 5: Ken, Bashiri, and Teoh disclose the claimed device except for the axial extension controlling member being composed of a twisted wire obtained by twisting together a plurality of metal wire materials.

Wilson teaches an axial extension controlling member being composed of a twisted wire obtained by twisting together a plurality of metal wire materials (page 4, paragraph 30). It would have been obvious to one of ordinary skill in the art at the time of invention to provide the axial extension controlling member being composed of a twisted wire, as taught by Wilson, to Ken, Bashiri, and Teoh since it was known in the art that braided or winded wires provide strength and resistance to breakage or fracture.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER